

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HIKMET HARMANOGLU

Appeal No. 2002-2136
Application No. 09/761,077

ON BRIEF

Before COHEN, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 2, which is the sole claim pending in this application.

We REVERSE and enter a new ground of rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a plastic bag for use in making bank deposits (specification, page 1). Claim 2, the sole claim pending in this application, reads as follows (with paragraph separation added to facilitate discussion infra):

2. An article of manufacture for making a manual after banking hours bank deposit as a substitution for a mail deposit vulnerable to loss during transit, said article of manufacture being in the specific form of embodied improvements in a bag of plastic material and of a type consisting of a rear panel having a front panel folded thereover to a selected extent delineating an uncovered upper strip along a top of said rear panel and having opposite heat sealed sides, said improvements comprising a vertically oriented bar seal of a selected width at a selected location intermediate said opposite sealed sides delineating on one side of said bar seal a first bag compartment having an opening therein and on an opposite side thereof a second bag compartment having an opening therein, a check bank deposit inserted into said first bag compartment and a cash bank deposit inserted into said second bag compartment, a line of perforations within said bar seal for use in separating said first and second bag compartments from each other, a horizontally oriented adhesive deposit along a bottom of said openings into said first and second bag compartments having in overlying relation a cooperating removable strip so as to expose said adhesive deposit and to adhesively hold said uncovered upper strip when in a folded-down relation over said openings into said first and second bag compartments to serve as closures for said bag compartments, a horizontally oriented line of perforations adjacent an upper edge of said adhesive deposit so as to delineate a removable length portion of said upper strip,

said length portion of said upper strip being removed along said horizontally oriented line of perforations and inscribed with an identification of a bank depositor, said removed and thusly inscribed length portion inserted into said second bag compartment in an interposed position between said rear panel and said front panel folded thereover to serve as identification of a bank depositor to be credited with said bank cash deposit in said second bag compartment, adhesive closing of said second bag compartment to complete a containment therein of said identification of the cash deposit to be credited to said bank depositor, and the manual deposit of said second bag compartment in a night bank repository,

whereby said high security afforded by said bank repository is substituted for the lesser security of mail transmission along with facilitated processing of said bank transaction as afforded by said inserted bank depositor identification in said second bag compartment.

The examiner relied upon the following prior art references of record in rejecting the appealed claim:

Fromm	2,840,295	Jun. 24, 1958
Gurewitz	4,720,040	Jan. 19, 1988
Makowka	4,733,817	Mar. 29, 1988

The following rejection is before us for review.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Makowka in view of Gurewitz and Fromm.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer

(Paper No. 10) for the examiner's complete reasoning in support of the rejection and to the brief and reply brief (Paper Nos. 9 and 11) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claim, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Before addressing the examiner's rejections based upon prior art, it is essential that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellants' claim 2 to derive an understanding of the scope and content thereof.

The preamble of appellant's claim 2 appears to indicate that the claim is directed to an article of manufacture for making a manual after hours bank deposit and, indeed, the first paragraph of claim 2, as reproduced supra, recites the article illustrated in

Figure 1, including the uncovered upper strip 28 and horizontally oriented line of perforations 46 delineating a removable length portion of the upper strip, with a check bank deposit inserted into one bag compartment and a cash bank deposit inserted into the other bag compartment. The second paragraph of the claim, as reproduced supra, on the other hand, recites steps of a method of using the article recited in the first paragraph, such as inscribing and removing the removable length portion of the upper strip and inserting it into the second bag compartment, adhesively closing the second bag compartment and manually depositing the second bag compartment in a night bank repository.

The purpose of the second paragraph of Section 112 is to basically insure, with a reasonable degree of particularity, an adequate notification, to those who would endeavor in the future to approach the area circumscribed by the claims of a patent, of the metes and bounds of what is being claimed so that they may readily and accurately evaluate the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). We also note that the statutory class of invention is important in determining patentability and infringement. As indicated by the court in In re Kuehl, 475 F.2d 658, 665, 177 USPQ 250, 255 (CCPA 1973), “each statutory class of claims must be considered independently on its own merits.”

In this instance, as discussed above, appellant's claim 2 combines two separate statutory¹ classes of invention in a single claim, namely, a manufacture and a process of using such manufacture. Accordingly, competitors would not be able to determine, with any degree of certainty, whether claim 2 is directed to the article of manufacture recited in the first paragraph of the claim or to the process of using such article of manufacture recited in the second paragraph of the claim so as to permit evaluation of the possibility of infringement. We thus conclude that appellant's claim 2 is not sufficiently precise to permit those who would endeavor in the future to approach the area circumscribed by claim 2 to ascertain with a reasonable degree of certainty the metes and bounds of the claimed invention as required by the second paragraph of 35 U.S.C. § 112. See Ex parte Lyell, 17 USPQ2d 1548, 1551 (Bd. Pat. App. & Int. 1990) and Ex parte Forsyth, 151 USPQ 55, 56 (Bd. Pat. App. & Int. 1966), wherein it is stated:

A claim such as those before us cannot be both method and apparatus. It must be clear by its wording that it is drawn to one or the other of these two mutually exclusive statutory classes of invention. A method or process, as indicated above, is an act or a series of acts and from the standpoint of patentability must distinguish over the prior art in terms of steps, whereas a claim drawn to an apparatus must distinguish in terms of structure.

¹ See 35 U.S.C. § 101, which requires that an invention, in order to be patentable, must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

In light of the above, we enter a new ground of rejection of appellant's claim 2 under the second paragraph of 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

We shall not sustain the examiner's 35 U.S.C. § 103 rejection of claim 2 as being unpatentable over Makowka in view of Gurewitz and Fromm. For the reasons expressed above, this claim is indefinite. Therefore, the prior art rejection must fall because it is necessarily based on speculative assumption as to the meaning of the claim. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

CONCLUSION

To summarize, the decision of the examiner to reject claim 2 under 35 U.S.C. § 103 is reversed and a new rejection of claim 2 under the second paragraph of 35 U.S.C. § 112 is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b), which provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options

with respect to the new ground of rejection to avoid termination of proceedings

(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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